

09/766,780

3

P-5686U1-D1

**REMARKS**

Reconsideration of the present application and entry of the amendment are respectfully requested. Claims 1 to 18 are currently pending, and claim 1 has been amended.

The Final Office Action mailed March 5, 2003 addressed claims 1 to 18. Claims 1 to 18 were rejected.

Claims 1 to 4 and 6 to 9 were rejected under 35 U.S.C. 102(e) as being anticipated by Yamagishi et al. (5,688,595). The Examiner stated that regarding claim 1, Yamagishi discloses a golf ball comprising a dual core and a single outer cover, and the dual core comprises a center component and a core layer. The Examiner further stated that the center component is made from a thermoset material and the core layer is made from a thermoplastic material, and the outer cover layer has a Shore D hardness from 40 to 60. The Examiner further stated that regarding claims 2, 4 and 6, the thermoset material for the core component is a polybutadiene and the thermoplastic material for the core layer is an ionomer; regarding claim 3, the core may comprise at least two layers; regarding claim 7, the center component has a diameter from 0.787 to 1.535 inches and the core component and core layer have a diameter from 1.378 to 1.614 inches; and regarding claims 8 and 9, Yamagishi discloses a variety of inert fillers that may be added to the core layers that are commonly known for increasing/decreasing density.

Applicants respectfully disagree with the Examiner. Yamagishi et al. is directed to a solid golf ball having a dual core and a soft multi-layer cover where the inner cover layer is softer than the outer cover layer to provide a soft feel and good spin and distance. Yamagishi specifically discloses that the inner cover layer must be softer than the outer cover layer. Yamagishi does not disclose a golf ball comprising a dual core and a single cover layer.

Since Yamagishi does not disclose each and every element of Applicants' claim 1, Applicants respectfully submit that Yamagishi does not anticipate claim 1. Claims 2 to 4 and 6 to 9 depend from claim 1 and therefore are also not anticipated by Yamagishi. Applicants respectfully request that the rejection of claims 1 to 4 and 6 to

09/766,780

4

P-5686U1-D1

9 under 35 U.S.C. 102(e) as being anticipated by Yamagishi et al. (5,688,595) be reconsidered and withdrawn.

Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al. (5,688,595) in view of Wu (5,334,673). The Examiner stated that Yamagishi discloses the invention as shown above but does not include polyurethane as an option for the thermoset material (core component), but Wu teaches a polyurethane golf ball product suitable for the core layer. The Examiner concluded that one skilled in the art would have modified the invention of Yamagishi by including a polyurethane core component to improve the resiliency of the golf ball.

As discussed above, Yamagishi does not disclose the invention because Yamagishi does not disclose a golf ball comprising a dual core and a single cover layer. Therefore, the addition of Wu for a polyurethane core component also does not disclose the invention.

For at least these reasons, Applicants respectfully submit that claim 5 is not obvious under 35 U.S.C. § 103(a) over Yamagishi et al. (5,688,595) in view of Wu (5,334,595). Applicants therefore respectfully request that the rejection of claim 5 under 35 U.S.C. § 103(a) as obvious over Yamagishi et al. (5,688,595) in view of Wu (5,334,595) be reconsidered and withdrawn.

Claims 10 to 13 and 15 to 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al. (5,688,595) in view of Maruko et al. (5,752,888). The Examiner stated that regarding claim 10, Yamagishi et al. discloses a golf ball comprising a dual core and a single outer cover, the dual core comprises a center component and a core layer, the center component is made from a thermoset material and the core layer is made from a thermoplastic material, and the outer cover layer has a Shore D hardness from 40 to 60. The Examiner further stated that regarding claims 11, 13, and 15, the thermoset material for the core component is a polybutadiene and the thermoplastic material for the core layer is an ionomer; regarding claim 12, the core may comprise at least two layers; regarding claim 16, the center core has a diameter from 0.787 to 1.535 inches and the core layer has a diameter from 1.378 to 1.614 inches; regarding claims 17 and 18, Yamagishi et al. discloses that filler may be

09/766,780

5

P-5686U1-D1

added to the core layers. The Examiner concluded that Yamagishi does not disclose the inner cover layer harder than the outer cover layer, however Maruko teaches an inner cover layer with a Shore D hardness greater than 60 and an outer cover layer with a Shore D hardness from 43 to 53, therefore one skilled in the art would have modified the hardness of the inner cover layer to achieve the desired flight characteristics of the golf ball.

Applicants respectfully disagree with the Examiner and submit that there is no motivation, teaching or suggestion to combine Maruko et al. with Yamagishi et al. Yamagishi et al. is directed to a solid golf ball having a dual core and a soft multi-layer cover where the inner cover layer is softer than the outer cover layer to provide a soft feel and good spin and distance. Yamagishi specifically discloses that the inner cover layer must be softer than the outer cover layer. Maruko et al. is directed to a wound golf ball having a multi-layer cover where the outer cover layer is softer than the inner cover layer. The cover configuration of Maruko is opposite that of Yamagishi because Maruko has an outer cover that is softer than the inner cover, while Yamagishi has an inner cover that is softer than the outer cover.

Applicants respectfully submit that one skilled in the art would not modify the cover of Yamagishi et al. with the cover of Maruko et al. First, Maruko et al. is a wound ball, and as Yamagishi et al. states, wound balls and solid golf balls perform differently. Second, Yamagishi et al. teaches away from golf balls having a soft outer cover and a hard inner cover layer. In the comparative examples, Yamagishi et al. discloses a golf ball having a soft outer cover layer and a harder inner cover layer, as well as a golf ball having a single hard cover, and both balls are rated as hard by the golfers testing them (see Table 1, examples CE1 and CE3). One reading Yamagishi et al. would have no reason to modify the cover such that the inner layer is harder than the outer layer.

Applicants respectfully submit that the Examiner has used impermissible hindsight to reconstruct Applicants' invention, and it is impermissible to pick and choose from one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what the reference fairly

09/766,780

6

P-5686U1-D1

suggests to one skilled in the art. A prior patent, such as Yamagishi et al. or Maruko et al., must be considered as a whole. One skilled in the art, when considering the references as a whole instead of picking and choosing only the portions that support the rejection, as the Examiner has done, would not be motivated to combine Maruko et al. and Yamagishi et al. Instead, when reading the two references and considering the teachings, one skilled in the art would be led away from combining the cover of Maruko et al. with the cover of Yamagishi et al. At most, it might be obvious to try the cover of Maruko et al. on the dual core of Yamagishi et al., but obvious to try is clearly not the standard.

For at least these reasons, Applicants respectfully submit that claims 10 to 13 and 15 to 18 are not obvious under 35 U.S.C. § 103(a) over Yamagishi et al. (5,688,595) in view of Maruko et al. (5,752,888). Applicants therefore respectfully request that the rejection of claims 10 to 13 and 15 to 18 under 35 U.S.C. § 103(a) as obvious over Yamagishi et al. (5,688,595) in view of Maruko et al. (5,752,888) be reconsidered and withdrawn.

Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al. (5,688,595) in view of Maruko et al. (5,752,888) as applied to claims 10 to 13 and 15 to 18 above and further in view of Wu (5,334,673). The Examiner stated that Yamagishi in view of Maruko discloses the invention as shown above but does not include polyurethane as an option for the thermoset material (core component), but Wu teaches a polyurethane golf ball product suitable for the core layer. The Examiner concluded that one skilled in the art would have modified the invention of Yamagishi in view of Maruko by including a polyurethane core component to improve the resiliency of the golf ball.

Applicants respectfully disagree with the Examiner. As previously discussed regarding claim 10, the combination of Yamagishi and Maruko does not disclose Applicants' golf ball having a dual core and a dual cover wherein the inner cover layer is harder than the outer cover layer. Therefore, the addition of Wu does not remedy the defect because Wu also does not disclose a golf ball having a dual core with the dual cover layer of Applicants.

09/766,780

7

P-5686U1-D1

For at least these reasons, Applicants respectfully submit that claim 14 is not obvious under 35 U.S.C. § 103(a) over Yamagishi et al. (5,688,595) in view of Maruko et al. (5,752,888) as applied to claims 10 to 13 and 15 to 18 above, and further in view of Wu (5,334,673). Applicants therefore respectfully request that the rejection of claim 14 under 35 U.S.C. § 103(a) as obvious over Yamagishi et al. (5,688,595) in view of Maruko et al. (5,752,888) as applied to claims 10 to 13 and 15 to 18 above, and further in view of Wu (5,334,673) be reconsidered and withdrawn.

Attached hereto is a marked-up version of the changes made to the application by this Amendment. The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

### CONCLUSION

Applicant respectfully requests reconsideration and allowance of each of the presently rejected claims, claims 1 to 18. Applicant respectfully requests allowance of claims 1 to 18, the claims currently pending.

Respectfully submitted,

MICHAEL J. SULLIVAN ET AL.

Customer No. 24492  
Phone: (413) 322-2937

Date: April 22, 2003

By: Michelle Bugbee  
Michelle Bugbee, Reg. No. 42,370  
Spalding Sports Worldwide  
Attorney for Applicants  
425 Meadow Street, P.O. Box 901  
Chicopee, MA 01021-0901

cc: Richard M. Klein, Esquire (SLD 2 0106-2)

09/766,780

8

P-5686U1-D1

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**  
**IN THE CLAIMS**

Claim 1 has been amended as follows:

1. (THREE TIMES AMENDED) A golf ball comprising:

a dual core having a center component and a core layer disposed about said center component; and, a cover disposed about said dual core;

wherein said center component comprises a thermoset material and said core layer comprises a thermoplastic material;

wherein said cover [includes] consists of a single cover layer having a Shore D hardness of from about 40 to 55.